

Application No.: 10/648,262

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REMARKS

Claims 1-2 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sampath. In order to expedite prosecution, claim 1 has been amended to incorporate the subject matter of claim 2 without prejudice/disclaimer to the subject matter embodied thereby. This rejection is respectfully traversed for the following reasons.

Claim 1 as amended recites in pertinent part, "wherein the database component with a tag in the variable-content database part has a nested structure in which a character train variable or a data variable with a tag are embedded." Regarding this feature of the present invention, the Examiner merely alleges that "the claim incorporates substantially similar subject matter as in claim 1, and is rejected along the same rationale" (see page 4, last two lines of April 26 Office Action). This assertion is respectfully traversed as being *per se* improper in that the Examiner merely groups the aforementioned feature of the present invention recited in old claim 2 as being somehow equivalent to that recited in old claim 1. In imposing a rejection under 35 U.S.C. §103, the Examiner is required to point to "page and line" wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). In the instant case, the Examiner does not address the aforementioned limitation at all, let alone specify the "page and line" where Sampath allegedly discloses such a feature. As described on page 13, line 31 - page 14, line 1 of Applicants' specification, a character train or a data variable with a tag may be nested in the tagged database component 153 as differentiated from a character train or a data variable with a tag not being placed in the tagged database component 153.

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In this regard, the Examiner's particular reliance on Sampath would teach away from the alleged database component with a tag in the variable-content database part having a nested structure in which a character train variable or a data variable with a tag are embedded. In sum, Sampath is completely silent as to the alleged database component with a tag in the variable-content database part having a *nested structure* in which a character train variable or a data variable with a tag are embedded.

It is noted that claim 1 references a "character train variable" and a "data variable with a tag" throughout the entire document creation routine. The Examiner appears to believe that these terms are non-distinguishable so that Sampath's disclosure of replacement values (see paragraph [0051] thereof) can be construed to read on both a "character train variable" and a "data variable with a tag." However, page 2, lines 11-19 of Applicants' specification expressly distinguishes between a "character train variable" and a "data variable with a tag." Specifically, Applicants' specification discloses (emphasis added):

[w]hen the character train variable is defined, one replaced by the definition of the character train variable *is a relatively simple word or the like*. In contrast, when the database component with a tag is defined, one replaced by the definition of the data variable with the tag *is a structured document, table, or figure having a combination of a plurality of words*. Therefore, the database component with a tag has a structure more complicated as compared to the structure of the character train variable.

Such a difference between a "character train variable" and a "data variable with a tag" is illustrated in Figure 7 of Applicants' drawings and described in the corresponding description thereof (see, e.g., page 11, line 27 – page 12, line 8 of Applicants' specification), where the data variable with tag 720 is a 3 x 2 table including a combination of a plurality of words, and character train variables 710, 711, 712 are simple words.

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Nonetheless, in order to overcome the Examiner's reliance on a "character train variable" and a "data variable with a tag" being non-distinguishable so as to read Sampath's disclosure of replacement values (see paragraph [0051] thereof) as both a "character train variable" and a "data variable with a tag, claim 1 has been further amended to differentiate between the two parameters. Specifically, "and" has been replaced with --or-- between the parameters to emphasize that a "character train variable" and a "data variable with a tag" are independent of each other so that the Examiner can no longer group them together as a single unit to read on Sampath's replacement values.

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claim 1 because the proposed combination fails the "all the claim limitations" standard required under § 103.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

### CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If

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there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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